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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/409,338	09/30/1999	MAKOTO YAMADA	030662-047	5232

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EXAMINER

SHOSHO, CALLIE E

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1714

DATE MAILED: 02/15/2002

14

Please find below and/or attached an Office communication concerning this application or proceeding.

T-2-14

Advisory Action	Application No. 09/409,338	Applicant(s) YAMADA ET AL.	
	Examiner Callie E. Shosho	Art Unit 1714	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 28 January 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 28 January 2002. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attachment.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: None.

Claim(s) objected to: None.

Claim(s) rejected: 1,2,5 and 8-12.

Claim(s) withdrawn from consideration: None.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____.

Attachment to Advisory Action

1. Applicants' amendment filed 1/28/02 and 1.132 declaration filed 1/31/02 have been fully considered but with the exception of arguments relating to Shimomura et al. (U.S. 5,866,638), Schwarz, Jr. (U.S. 5,990,198), and Gundlach et al. (U.S. 6,054,505), they are not persuasive.

(a) With respect to Nigam et al., applicants argue that Nigam et al. do not disclose each and every feature of the claimed invention, i.e. Nigam et al. do not disclose combination of glycerol and basic polymer having a side chain containing 1-imidazolyl. However, it is the examiner's position that given that Nigam et al. disclose an ink jet ink comprising azo dye, aqueous medium, glycerol, and basic polymer having a side chain containing 1-imidazolyl, Nigam et al. meets each and every limitation of the present claims and thus, the claims are properly anticipated by Nigam et al. Although there are no examples of an ink comprising both glycerol and basic polymer having a side chain containing 1-imidazolyl, "applicant must look to the whole reference for what it teaches. Applicant cannot merely rely on the examples and argue that the reference did not teach others." *In re Courtright*, 377 F.2d 647, 153 USPQ 735,739 (CCPA 1967). Further, "nonpreferred disclosures can be used. A nonpreferred portion of a reference disclosure is just as significant as the preferred portion in assessing the patentability of claims." *In re Nehrenberg*, 280 F.2d 161, 126 USPQ 383 (CCPA 1960).

Applicants 1.132 declaration compares inks within the scope of the present claims, i.e. comprising glycerol and basic polymer having a side chain containing 1-imidazolyl (examples 21-24) with inks outside the scope of the present claims, i.e. comprising basic polymer having a side chain containing 1-imidazolyl but no glycerol (comparative examples 23-28). However,

given that Nigam et al. already disclose an ink which comprises glycerol and basic polymer having a side chain containing 1-imidazolyl, the results of the comparisons in the declaration are not believed to be unexpected or surprising with respect to Nigam et al.

Thus, Nigam et al. remains a relevant reference against the present claims.

(b) With respect to Bates et al. in view of Breton et al. and Nigam et al., applicants argue that Bates et al. do not disclose specific combination of glycerol and basic polymer having a side chain containing 1-imidazolyl and further that glycerol, i.e. glycerine, is listed among a long list of possible humectants in Bates et al.

However, it is noted that among the humectants listed in col.7, lines 34-42 of Bates et al., the majority of the humectants are polyols of which glycerine is one. Thus, it is clear from Bates et al. that the use of glycerine in ink jet inks is known.

Applicants also argue on pages 9-10 of the amendment filed 1/28/02 that Bates et al. do not disclose basic polymer having a side chain containing 1-imidazolyl. However, this argument is not understood given that Bates et al. disclose the use of poly(1-vinylimidazole) in col.9, line 65-col.10, line 5 and 1-vinylimidazole/N-vinyl pyrrolidone in col.10, lines 29-36 which are identical to polymers A-4 and A-23 disclosed on pages 10-11 of the present specification.

Applicants also argue that Breton et al. do not disclose ink as presently claimed. However, it is noted that Breton et al. is only used as a teaching reference in order to provide evidence that the dye already disclosed in Bates et al. is in fact an azo dye.

Additionally, applicants argue that no prima facie case of obviousness is present given that the three basic criteria for establishing obviousness, i.e. (1) there must be some suggestion or

motivation to modify the reference or combine reference teachings, (2) there must be a reasonable expectation of success, and (3) the prior art reference or references when combined must teach or suggest all the claim limitations, have not been met. It is the examiner's position that these three criteria have been met given that Bates et al. disclose all the limitations of the present claims with the exception of the viscosity of the ink. However, given that it is well known that if the viscosity of the ink is too high, the ink clogs the printer nozzles, it would have been obvious to one of ordinary skill in the art to control the viscosity of the ink jet ink in Bates et al. to avoid printer clogging. Such viscosity is taught in Nigam et al., which discloses that the viscosity of an ink jet ink is typically 1.5-15 cP. Thus, given that there is motivation to control the viscosity of the ink and given that Bates et al. disclose an ink containing identical ingredients as presently claimed, it is clear that a prima facie case of obviousness has been established.

Applicants 1.132 declaration compares inks within the scope of the present claims, i.e. comprising glycerol and basic polymer having a side chain containing 1-imidazolyl (examples 21-24) with inks outside the scope of the present claims, i.e. comprising basic polymer having a side chain containing 1-imidazolyl but no glycerol (comparative examples 23-28).

When comparing example 21 with comparative example 24, for instance, as found in Table 3, page 5 of the declaration, the ink of example 21 rates A in hue and resistance for photo paper while the ink of comparative example 24 rates B in hue and resistance for photo paper. As stated on page 2 of the declaration, an A rating in hue corresponds to a values of less than 80 nm while a B rating in hue corresponds to a measurement of 80-100 nm. Similarly, an A rating in resistance corresponds to a measurement of more than 80% dye residual, while a B rating in resistance corresponds to a measurement of 60-80% dye residual. Thus, a difference in hue

Art Unit: 1714


between A and B, as found when comparing the ink of example 21 (ink with glycerol) with ink of comparative example 24 (no glycerol), can be as little as 1 nm, i.e. 79 nm (A) versus 80 nm (B) for hue and 1%, i.e. 81% (A) versus 80% (B) for resistance. Such differences are not unexpected or surprising. Further, applicants are reminded that patent law upholds that "[when] the result sought and the ingredients used were known...it was within the expected skills of one having ordinary skill in this art to arrive at the optimum proportion of those ingredients" *In re Reese*, 290 F.2d 839, 129 USPQ 402, 406 (CCPA 1961) and that "improvement over prior art still may not be patentable if it is within the capabilities of one skilled in the art, ..., unless there is an unexpected result that is different in kind, not just in degree, from the results of the prior art", *In re Huang*, 100 F.3d 135, 139, 40 USPQ2d 1685, 1689 (Fed. Cir. 1996).

Thus, Bates et al. remains a relevant reference against the present claims.



Callie Shosho

2/13/02


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